

REMARKS

Upon entry of the instant Amendment, claims 1-18 will be pending in the application. By this amendment, claims 13-18 will have been added. No new matter is added. Support for new claims 13-18 can be found on paragraphs [0006] and [0011] of the published version of the instant application, i.e., US No. 2003/0140013.

Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. § 101 Rejection

Claims 1-12 were rejected under 35 U.S.C. § 101 for being allegedly being directed to non-statutory subject matter.

The Examiner asserts that claims 1-12 are directed to non-statutory subject matter at least because they do not provide a concrete result. Applicants respectfully disagree that the above-noted claims do not recite patentable subject matter.

Applicants direct the Examiner's attention to MPEP 2106, and specifically to the section entitled "Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity)." This section specifically explains that a "statutory process is one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data (*In re Gelnovatch*, 595 F.2d 32, 41 n.7, 201 USPQ 136, 145 n.7 (CCPA 1979) (data-gathering step did not measure physical phenomenon); *Arrhythmia*, 958 F.2d at 1056, 22 USPQ2d at 1036), where the data comprises signals corresponding to physical objects or activities external to the

computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities.

Schrader, 22 F.3d at 294, 30 USPQ2d at 1459 citing with approval *Arrhythmia*, 958 F.2d at 1058-59, 22 USPQ2d at 1037-38; *Abele*, 684 F.2d at 909, 214 USPQ at 688; *In re Taner*, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982)." The Examiner is not correct that the claims do not recite one or more steps which involve pre-computer process activity.

Claim 1 recites a method for determining a per-point price for data processing services using a computing device, comprising the steps of, among other things, for each unit of a plurality of units of data processing services, determining a level of environmental complexity, a level of change, and a type of environment. As explained in paragraphs [0017] - [0019] and [0027] of the instant published application, the invention allows the system integrator (i.e., user) to determine and select the level of complexity and to enter into the computer a base-line price. As such, the invention necessarily requires that the user evaluate the customer request or change in order to allow the user to choose the appropriate complexity level. Such activities take place outside the computer activities and are performed prior to the computer performing one or more of the recited steps. Thus, the Examiner is not correct that claim 1 does not provide for any pre-computer process activity.

Additionally, claim 8 recites a method for determining a per-point price for data processing services using a computing device, comprising the steps of, among other things, for each unit of a plurality of units of data processing services, selecting a level

of environmental complexity from a plurality of predetermined levels of environmental complexity, selecting a level of change from a plurality of predetermined levels of change, and selecting a type of environment from a plurality of predetermined types of environments. Again, as explained in paragraphs [0017] - [0019] and [0027] of the instant published application, the invention allows the system integrator (i.e., user) to determine and select the level of complexity and to enter into the computer a base-line price. As such, the invention necessarily requires that the user evaluate the customer request or change in order to allow the user to choose the appropriate complexity level. Such activities are clearly outside the computer activities and are performed prior to the computer performing one or more of the recited steps. Thus, the Examiner is not correct that claim 8 does not provide for any pre-computer process activity.

Finally, claim 10 recites a method for adjusting a baseline price of data processing services when a unit is added using a computing device, comprising the steps of, among other things, determining, from a baseline price, a per-point price for data processing services and determining a level of environmental complexity, a level of change, and a type of environment for a unit to be added to the data processing services. Again, as explained in paragraphs [0017] - [0019] and [0027] of the instant published application, the invention allows the system integrator (i.e., user) to determine and select the level of complexity and to enter into the computer a base-line price. As such, the invention necessarily requires that the user evaluate the customer request or change in order to allow the user to choose the appropriate complexity level. Such activities are also clearly outside the computer activities and are performed prior to the

computer performing one or more of the recited steps. Thus, the Examiner is not correct that claim 10 does not provide for any pre-computer process activity.

On page 5 of the instant Office Action, the Examiner acknowledges that the invention is useful and tangible, but asserts that it does not produce "any concrete result." Applicants respectfully disagree.

Applicants refer the Examiner to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" issued on November 22, 2005. In the noted guidelines, the USPTO describes the concrete result consideration in evaluating a Section 101 rejection as follows:

Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. Sec. 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. Sec. 112, paragraph 1, where the invention cannot operate as intended without undue experimentation. See infra.

Applicants respectfully submit that it does not appear that the Examiner has complied with such guidelines in finding that Applicants have not established any concrete result. For example, the Examiner has not shown, or even alleged, that the claimed methods would produce non-repeatable results or would otherwise produce unpredictable results. Nor has the Examiner even considered (or discussed in the

instant Office Action) the level of skill in the art. Finally, the Examiner has not even alleged that "the invention cannot operate as intended without undue experimentation".

Nor can the Examiner satisfy the guidelines because the instant application clearly produces a concrete result, i.e., it provides novel methods of pricing data processing services based on requests or changes from customers (see paragraph [0015] of the instant published application).

Claims 2-7, 9, 11 and 12 depend from claims 1, 8 and 10 and therefore also clearly recite statutory subject matter.

Accordingly, Applicants respectfully request that the above-noted rejection under 35 U.S.C. § 101 be withdrawn.

New Claims are also Allowable

Applicants submit that the new claims 13-18 are allowable over the applied art of record. Specifically, claims 13-18 depend from claims 1, 8 and 10 which are believed to be allowable. Additionally, claims 13-18 recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Accordingly, Applicants respectfully request consideration of these claims and further request that the above-noted claims be indicated as being allowable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for

allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Any fees required for consideration of the instant response are hereby authorized to be charged to our Deposit Account No. 09-0457.

Respectfully submitted,
C. W. FELLENSTEIN et al.



Andrew M. Calderon
Reg. No. 38,093

Stephen M. Roylance
Reg. No. 31,296

June 23, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
703-716-1191